REMARKS:

Applicant has carefully studied the Final Examiner's Action and all references cited therein. The amendment appearing above and these explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is now believed to be in condition for allowance.

Applicant responds to the outstanding Action by centered headings that correspond to the centered headings employed by the Office, to ensure full response on the merits to each finding of the Office.

Claim Rejection 35 U.S.C. 103(a)

Claims 1-4, and 8-14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Eggers et al. (U.S. Patent No. 6,623,454) as modified by Eggers et al.

The Office states that Eggers et al. discloses in Fig. 19, a device comprising an elongated member comprising a cylindrical core electrode (118) surrounded by a first nonconductive insulator sleeve (108); a first electrode, and a second nonconductive sleeve being in independent circuit communications with a respective portion of a source of electrical energy, the electrodes begin fully capable of being able to establish an electromagnetic field in vivo to cause electromigration of molecules and transient permeability of cell membrane; and the device further having a portal (132) through which a substance may be passed. While the Office admits that Eggers et al. does not expressly disclose a second electrode member and a third nonconductive insulator sleeve, the Office concludes that at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to add an additional electrode and insulating layer because Applicant has not disclosed that having three electrodes and three insulating sleeves as opposed to two provides an advantage, is used for a particular purpose, or solves a stated problem. As such, the Office concludes that it would have been an obvious matter of design choice to modify Eggers et al. with an additional electrode and insulating layer to obtain the invention as specified in claims 1 and 12.

Applicant respectfully disagrees with this finding by the Office.

Independent claims 1 and 12 of the present invention include an elongated member comprising a generally cylindrical conductive core electrode; a first nonconductive insulator sleeve positioned in surrounding relation to a portion of the core electrode, with a lower portion of the core electrode extending axially beyond the first insulator sleeve; a first electrode member positioned in surrounding relation to a portion of the first nonconductive insulator sleeve, with a lower portion of the first insulator sleeve extending axially beyond the first electrode member; a second nonconductive insulator sleeve positioned in surrounding relation to a portion of the first electrode member, with a lower portion of the first electrode member extending axially beyond the second insulator sleeve; a second electrode member positioned in surrounding relation to a portion of the second insulator sleeve, with a lower portion of the second insulator sleeve extending axially beyond the second electrode member; a third nonconductive insulator sleeve positioned in surrounding relation to a portion of the second electrode member, with a lower portion of the second electrode member extending axially beyond the third insulator sleeve, each electrode being in independent circuit communication with a respective portion of a source of electrical energy.

The Office has concluded that at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to add an additional electrode and insulating layer because Applicant has not disclosed that having three electrodes and three insulating sleeves as opposed to two provides an advantage, is used for a particular purpose, or solves a stated problem. Applicant respectfully disagrees with this conclusion by the Office.

The present application, as originally filed, describes a device for manipulating a molecule *in vivo* relative to a target tissue wherein three-dimensional manipulation can be effected by activating opposing pairs of electrodes at different axial levels to induce molecular movement and/or electropermeabilization along a desired pathway. In an exemplary embodiment, with reference to Fig. 3 and Fig. 4, activating the pair **13-13'** would induce movement generally in a plane normal to the member **12,** whereas activating the pair **13-15'** would induce movement at an angle relative to the plane. As such, the Applicant has disclosed an advantage and particular purpose for having three electrodes and three insulating sleeves as

opposed to two and that these additional electrodes and insulating sleeves are used for a particular purpose. Accordingly, Applicant disagrees with the conclusion by the Office that it would have been an obvious matter of design choice to a person of ordinary skill in the art to add an additional electrode and insulating layer because Applicant has not disclosed that having three electrodes and three insulating sleeves as opposed to two provides an advantage, is used for a particular purpose, or solves a stated problem.

Response to Arguments

In the Response to Arguments on page 3 of the Final Office Action, the Office states that the Applicant's arguments filed on 8/22/2008 have been fully considered but they are not persuasive. Applicant contends that the Office has not fully considered the arguments filed on 8/22/2008 because the Office has failed to address all the arguments presented by the Applicant.

In particular, the Office has failed to address the argument presented by the Applicant that it would not have been an obvious matter of design choice to a person of ordinary skill in the art to add an additional electrode and insulating layer because the application as filed provides an advantage and particular purpose for having three electrodes and three insulating sleeves as opposed to two and that these additional electrodes and insulating sleeves are used for a particular purpose.

In the previous Non-Final Office action, the Office stated that, "it would have been an obvious matter of design choice to a person of ordinary skill in the art to add an additional electrode and insulating layer because Applicant has not disclosed that having three electrodes and three insulating sleeves as opposed to two provides an advantage, is used for a particular purpose, or solves a stated problem". However, Applicant pointed out in the previous response that the application ***does*** disclose an advantage and particular purpose for having three electrodes and three insulating sleeves as opposed to two and that these additional electrodes and insulating sleeves are used for a particular purpose. More particularly, the response filed on 8/22/2008 states on page 6 that,

> "The present application, as originally filed, describes a device for manipulating a molecule *in vivo* relative to a target tissue wherein three-dimensional manipulation can be effected by activating opposing pairs of electrodes at different axial levels to induce molecular movement and/or electropermeabilization along a desired pathway. In an exemplary embodiment, with reference to Fig. 3 and Fig. 4, activating the pair **13-13'** would induce movement generally in a plane normal to the member **12,** whereas activating the pair **13-15'** would induce movement at an angle relative to the plane."

The Office has failed to address this argument presented by the Applicant.

Applicant contends that independent claims 1 and 12 are patentable over Eggers, as modified by Eggers, because the Office has failed to establish a *prima facie* case of obviousness. More particularly, the Office has failed to establish that it would have been an obvious matter of design choice to modify Eggers et al. with an additional electrode and insulating layer to obtain the invention because the Office has failed to address the argument presented by the Applicant that having three electrodes and three insulating sleeves as opposed to two provide an advantage, is used for a particular purpose, or solves a stated problem as has been pointed out to the Office in the specification.

Applicant respects that the rejection of claims 1 and 12 be withdrawn, or that the Office provide a response to the argument presented by the Applicant regarding the disclosed advantages of having three electrodes and insulating sleeves as opposed to two.

Claims 2-11 and 13 are dependent upon claim 1, which has been shown to be allowable, and are therefore allowable as a matter of law.

Claim 14 is dependent upon claim 12, which has been shown to be allowable, and is therefore allowable as a matter of law.

If the Office is not fully persuaded as to the merits of Applicant's position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (813) 925-8505 is requested.

Very respectfully,

SMITH & HOPEN

By:_____

Dated: December 10, 2008

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Agent for Applicants

CERTIFICATE OF ELECTRONIC TRANSMISSION
(37 C.F.R. 2.190(b))

I HEREBY CERTIFY that this correspondence is being electronically transmitted to the Patent and Trademark Office through EFS Web on December 10, 2008.

/erica gossage/

Date: December 10, 2008

Erica Gossage